



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,979	03/27/2000	Tomasz Duczmal	856.1043	4057

21171 7590 05/06/2003

STAAS & HALSEY LLP  
700 11TH STREET, NW  
SUITE 500  
WASHINGTON, DC 20001

EXAMINER

NGUYEN, NHON D

ART UNIT PAPER NUMBER

2174

DATE MAILED: 05/06/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/535,979

Applicant(s)

DUCZMAL ET AL.

Examiner

Nhon (Gary) D Nguyen

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6-9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is responsive to Amendment A, filed 2/14/2003.
2. Claims 1, 6-9, and 11-16 are pending in this application. Claims 1 and 11 are independent claims. In the Amendment A, claims 2-5, 10, and 17 are cancelled, and claims 1 and 11-14 are amended. This action is made final.

### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

In this application, abstract should avoid using the phrase "the present invention".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2174

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 6, 8, and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ballard (US 6,182,050).

As per claim 1, Ballard teaches a system for dynamic display of advertising material via a network comprising:

a plurality of input sources for receiving scheduling information and advertising material in the form of at least one image object for scheduling display of said advertising material during an allocated time slot (col.8, lines 46-50; col.10, lines 61-65);

a database for storing said at least one image object (col. 6, lines 40-41);

a server for managing said advertising material in accordance with said scheduling information (col. 6, lines 26-33); and

at least one billboard (*end user computer 14* of fig. 3) for displaying said at least one image object during said allocated time slot and, prior to expiry of said allocated time slot, triggering a communication session with said server to upload and display a further image object during a respective further time slot (col. 10, lines 53-67).

As per claim 6, Ballard teaches the system wherein the server comprises:

a distribution engine for uploading said scheduling information and said advertising material from said plurality of input sources, for managing said advertising material and for providing said advertising material to said at least one display location (col.8, lines 46-50; col.10, lines 60-65); and

a slot allocator for monitoring said scheduling of said display (col. 10, lines 60-65).

As per claim 8, Ballard teaches the system wherein the server further comprises a monitoring system for providing a view of the advertising material, allocated to a display location, to at least one of the plurality of input sources (col. 10, lines 1-15; when considering the advertiser to be a subset of the locations retrieving the advertisement, it is inherent that the advertisement can be viewed by the advertiser if the advertiser tunes/logs in to view, the ad at the time allocated for displaying the ad).

Claim 11 is similar in scope to claims 1 and 6, and is therefore rejected under similar rationale.

As per claims 12-13, Ballard teaches the step of searching for a billboard before the step of selecting a time slot from the available time slots and retrieving billboard location data (col. 10, lines 47-65).

As per claim 14, Ballard teaches the step of checking said advertising material for technical integrity before the step of storing said advertising material in said database (inherent step performed by databases in order to prevent data corruption).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7, 9, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (US 6,182,050).

As per claim 7, Ballard teaches the system wherein the server further comprises a transaction system for enabling payment and status checking (col.10, lines 36-41). However, Ballard does not explicitly disclose the transaction system for enabling cancellations. Official Notice is given that provision for operations such as initiation and cancellation of transactions within a marketing system were well known in the art at the time of the invention. It would have been obvious to an artisan at the time of the invention to include the enabling of cancellations with Ballard's teaching in order for the advertiser to withdraw the display of advertisements that are no longer desired.

As per claim 9, Ballard teaches the system wherein the server further comprises: a location identifier for providing description, statistical and technical information concerning said at least one display, location to at least one of said plurality of input sources (col.6, lines 64-67; col.7, lines 1-12).

As per claims 15-16, Ballard teaches the step of performing financial transactions wherein the step of performing financial transactions comprises the steps of calculating transaction fees and aggregating airtime information (col. 10, lines 29-41). Although, Ballard teaches the financial transactions to be performed during the subscription process, Ballard does not disclose the transactions to take place before uploading the advertising material. Official Notice is given that financial transactions taking place prior to granting a service such as in the example of charging a flat fee before providing a service was well known in the art at the time of the invention. It would have been obvious to an artisan at the time of the invention to perform financial transactions before further processing with Ballard's teaching as a choice of business practice.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1 and 11 have been considered but they are not persuasive.

As per independent claims 1 and 11, applicants argued the amendment to claim 1 makes clear that applicant's invention is directed to public displays and in particular billboards, rather than end user PCs and individual viewing of advertisements, as in Ballard. Furthermore, claim 1 has been amended to recite applicant's inventive feature by which the billboard triggers a communication session with the server to upload the next valid image object to the billboard upon expiry of the validity period of the allocated time slot. The foregoing is an important distinction from Ballard wherein the computer 52 "pushes" advertising material to end users on a

Art Unit: 2174

subscription basis. As amended, claim 1 sets forth a polling technique rather than a pushing technique, resulting in greater security than the system of Ballard.

However, the examiner disagrees for the following reasons:

The claimed languages on claims 1 and 11 themselves are still being read in light of Ballard's teaching. End user computers 14 (fig. 3) can post advertisements (col.10, lines 12-15), and furthermore, these advertisements can be posted to one or more demographic groups of end user computers (col. 6, lines 64-67 through col. 7, lines 1-13); therefore, end user computer 14 is in fact a billboard. Also according to Ballard, the ASP computer 52 (fig. 3) manages to select the proper advertisements displayed on the end computer user 14 (billboard) based upon a time slot (col. 10, lines 60-65); therefore, for example, when more than one advertisement schedule is to be displayed on a demographic group of end user computers 14, the ASP computer 52 schedules a continuous display of advertisements upon the time slots of the previous ones are expiring.

9. Applicant's failure to adequately traverse the Examiner's taking of Official Notice in the last office action is taken as an admission of the fact(s) noticed.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after



Art Unit: 2174

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Inquiries*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhon (Gary) D Nguyen whose telephone number is 703-305-8318. The examiner can normally be reached on Monday - Friday from 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kistine L Kincaid can be reached on 703-308-0640. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Nhon (Gary) Nguyen  
May 5, 2003

*Kristine Kincaid*  
KRISTINE KINCAID  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100